UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,576	11/21/2000	John F. Fairclough	TRO4-BK25	2130

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EXAMINER
WINTER, JOHN M

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _08 April 2003_ .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-20_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1,3-7,9,10,12 and 14-20_ is/are rejected.

7)☒ Claim(s) _2,8,11,and 13_ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

DETAILED ACTION

Status
Claims 1-19 remain pending
Claim 20 has been added.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Response to Arguments

The applicant's arguments filed on April 8, 2003 have been fully considered but are not persuasive.

As per claim 12,
The Applicant states that the claims of the present invention are directed towards a different purpose and are not obvious in view of the prior art.

Examiner responds that as per *Ex parte Clapp*, 227 USPQ 972 (Bd Pat App & Int) "To support conclusion that claimed combination is directed to obvious subject matter, the references must either expressly or impliedly suggest claimed combination or the examiner must present a convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of the references teachings.", the Examiner states the reference deals with the generalized problem of conducting secure electronic commerce and therefore would be obvious to a person of ordinary skill in the art.

The Applicant states that Pare Jr. reference does not disclose the intended function of " connecting a client to a mechant server at a location remote from the client computer.

The Examiner responds that the Pare Jr. reference discloses "network point of sales transactions (i.e. involving a client and a server), and that the clients biometric information is submitted via public ATM (i.e. remote from the server), thusly the Pare Jr reference meet the claimed limitations of the invention.

The Applicant states that Pare Jr. reference does not disclose the feature of " transmitting an order to a client computer".

The Examiner responds that the Pare Jr. reference discloses "the transaction amount includes all of the data that is necessary for conducting a transaction such as price information, a list of goods and services, a payee name ....(Column 15, lines 38-42)" although Pare Jr, does not explicitly state that an order was places he does provide a list of goods and services provided, it is obvious that such a list could only be derived from an order that was placed by the customer. As per *In re Bozek*, 163 USPQ 545 (CCPA 1969) "reference disclosure must be evaluated for all that it fairly suggests, and not only what is indicated as preferred.

The Applicant states that Pare Jr. reference does not fairly disclose the feature of "selecting payment by check".

The Examiner responds that there is no language in the claim regarding the details of how the check processing is handled, if the Pare Jr. reference discloses an automated process this still meets the limitation disclosed by the applicant. Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 26 USPQ2d 1057 (CA FC 1993).

The Applicant states that Pare Jr. reference does not fairly disclose the feature of "connecting the client computer to a check server".

The Examiner responds that there is no language in the claim regarding the details of how the check processing is handled specifically in regard to who retains control of the transaction. Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 26 USPQ2d 1057 (CA FC 1993)

The Applicant states that Pare Jr. reference does not fairly disclose the feature of "inputting customer data at the client computer".

The Examiner responds that there is no language in the claim regarding the details of how inputting client data is handled. Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 26 USPQ2d 1057 (CA FC 1993)

As per claim 1,

The Applicant states that Pare Jr. reference does not fairly disclose the feature of printing a check document that can be negotiated.

The Examiner responds that the newly discovered reference Thomas et al. (US Patent 5,393,963) discloses this feature, however this feature is not a limitation of the currently claimed invention.

The Applicant states that there is no motivation to combine Pare Jr. and Carlson.

Examiner responds that as per *Ex parte Clapp*, 227 USPQ 972 (Bd Pat App & Int) "To support conclusion that claimed combination is directed to obvious subject matter, the references must either expressly or impliedly suggest claimed combination or the examiner must present a convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of the references teachings.", the Examiner states the reference deals with the generalized problem of conducting secure electronic commerce and therefore would be obvious to a person of ordinary skill in the art.

As per claim 3,

The Applicant states that there is no motivation to combine Pare Jr. and Carlson.

Examiner responds that as per *Ex parte Clapp*, 227 USPQ 972 (Bd Pat App & Int) "To support conclusion that claimed combination is directed to obvious subject matter, the references must either expressly or impliedly suggest claimed combination or the examiner must present a convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of the references teachings.", the Examiner states the reference deals with the generalized problem of conducting secure electronic commerce and therefore would be obvious to a person of ordinary skill in the art.

As per claim 4,
The Applicant states that the printer discloses by Carlson is unsecure.
The Examiner responds that although Carlson does not specifically disclose the security measures were taken, Carlson's printer is not connected to any type of network, thus it is secure in that it can receive no communications from any point outside the local system.

As per claim 5, 9, 16-19
The Applicant states that there is no motivation to combine Pare Jr. and Hills.
Examiner responds that as per *Ex parte Clapp*, 227 USPQ 972 (Bd Pat App & Int) "To support conclusion that claimed combination is directed to obvious subject matter, the references must either expressly or impliedly suggest claimed combination or the examiner must present a convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of the references teachings.", the Examiner states the reference deals with the generalized problem of conducting secure electronic commerce and therefore would be obvious to a person of ordinary skill in the art.
Dependant claim 6 is rejected for at least the same reasons as claim 5

As per Claim 7
The Applicant states that it would not be obvious to combine the Pare Jr. reference with the Carlson reference in order to generate a paper check that is routable via standard bank routing procedures.
Examiner responds that as per *Ex parte Clapp*, 227 USPQ 972 (Bd Pat App & Int) "To support conclusion that claimed combination is directed to obvious subject matter, the references must either expressly or impliedly suggest claimed combination or the examiner must present a convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of the references teachings.", the Examiner states the reference deals with the generalized problem of conducting secure electronic commerce and therefore would be obvious to a person of ordinary skill in the art.

As per Claim 10
The Applicant states that Pare Jr. reference discloses a confirmation step that is different than the approval step claimed.
The Examiner responds that the claim itself makes no assertion as to when the client data was gathered. Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 26 USPQ2d 1057 (CA FC 1993)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claim 12 is rejected under 35 U.S.C. 102(e) as being unpatentable over Pare, Jr. et al. (US Patent No 6,230,148).

As per claim 12,
Pare Jr. et al. ('148) discloses a method for settling and verifying checks over a network comprising the following steps:
connecting a client computer to a merchant server at a location remote from the client computer;(column 14, lines 34-42)
transmitting an order from the client computer to the merchant server; (figure 4)
selecting payment by check; (figure 6)
connecting the client computer to a check server;(column 13, lines 66-67; column 14, lines 1-19)
inputting customer data at the client computer; (column 13, line 64)
transmitting customer data from the client computer to the check server; (column 13, line 66-67; column 14, lines 1-2)
transmitting customer data from the check server to a check verification server; (column 15, line 1-7)
transmitting an approval from the check verification server to the check server (column 15, line 1-7)
settling a check by an ACH settlement system.(Figure 7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 13 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Pare, Jr. et al. (US Patent No 6,230,148) in view of Carlson et al. (US Patent No 5,053,607).

As per claim 1,
Pare Jr. et al. ('148) discloses a method for printing and verifying checks over a network
comprising the following steps:
connecting a client computer to a merchant server at a location remote from
the client computer;(column 14, lines 34-42)
transmitting an order from the client computer to the merchant server; (figure 4)
selecting payment by check; (figure 6)
connecting the client computer to a check server;(column 13, lines 66-67; column 14,
lines 1-19)
inputting customer data at the client computer; (column 13, line 64)
transmitting customer data from the client computer to the check server; (column 13, line
66-67; column 14, lines 1-2)
transmitting customer data from the check server to a check verification
server; (column 15, line 1-7)
transmitting an approval from the check verification server to the check
server (column 15, line 1-7)
Pare Jr. et al. ('148)does not explicitly disclose printing a check
Carlson et al. ('607) discloses printing a check.(Figure 6) It would be obvious to one having
ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al.
('148) method with the Carlson et al. ('607) method in order to allow the seller to generate
physical proof of the transaction.

As per claim 3,
Pare Jr. et al. ('148) discloses the method of Claim 1
where the network is the Internet.(Figure 4)

As per claim 4,
Pare Jr. et al. ('148) discloses the method of Claim1
Pare Jr. et al. ('148)does not explicitly disclose the check is printed by a secure printer
connected to a check printing station at the remote location. Carlson et al. ('607) discloses
the check is printed by a secure printer connected to a check printing station at the remote
location (Column 10, lines 8-53; Figure 6) It would be obvious to one having ordinary skill
in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with
the Carlson et al. ('607) method in order to allow the seller to generate physical proof of the
transaction.

As per claim 14
Pare Jr. et al. ('148) discloses the method of Claim 12

Pare Jr. et al. ('148) does not explicitly disclose the network is the ACH network. Hills et al. ('528) discloses the network is the ACH network. (Abstract) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Hills et al. ('528) method in order to utilize a well known and commercially viable system for check clearing.

As per claim 15
Pare Jr. et al. ('148) discloses the method of Claim 12
Pare Jr. et al. ('148) does not explicitly disclose storing the approval from the check verification server in a merchant file in the check server; downloading the merchant file from the check server to the ACH settlement system. Hills et al. ('528) discloses storing the approval from the check verification server in a merchant file in the check server;(Abstract) downloading the merchant file from the check server to the ACH settlement system (Column 12, lines 54-67) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Hills et al. ('528) method in order to protect the merchant from fraud caused by a customer with insufficient funds to cover the check.

Claim 5-11, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pare, Jr. et al. (US Patent No 6,230,148) in view of Carlson et al. (US Patent No 5,053,607) and further in view of Hills et al. (US Patent No 6,164,528)

As per claim 5,
Pare Jr. et al. ('148) discloses the method of Claim 1
Pare Jr. et al. ('148) does not explicitly disclose storing the approval from the check verification server in a merchant file in the check server; downloading the merchant file from the check server to a check printing station. Hills et al. ('528) discloses storing the approval from the check verification server in a merchant file in the check server;(Abstract) downloading the merchant file from the check server to a check printing station (Column 12, lines 54-67) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Hills et al. ('528) method in order to protect the merchant from fraud caused by a customer with insufficient funds to cover the check.

As per claim 6,
Pare Jr. et al. ('148) discloses a method for printing and verifying checks over a network comprising the following steps:
connecting a client computer to a merchant server at a location remote from the client computer;(column 14, lines 34-42)
transmitting an order from the client computer to the merchant server; (figure 4)
selecting payment by check; (figure 6)
connecting the client computer to a check server;(column 13, lines 66-67; column 14, lines 1-19)
inputting customer data at the client computer; (column 13, line 64)

transmitting customer data from the client computer to the check server; (column 13, line 66-67; column 14, lines 1-2)

transmitting customer data from the check server to a check verification server; (column 15, line 1-7)

transmitting an approval from the check verification server to the check server (column 15, line 1-7)

Pare Jr. et al. ('148) does not explicitly disclose storing the approval from the check verification server in a merchant file in the check server; downloading the merchant file from the check server to a check printing station. Hills et al. ('528) discloses storing the approval from the check verification server in a merchant file in the check server;(Abstract) downloading the merchant file from the check server to a check printing station (Column 12, lines 54-67) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Hills et al. ('528) method in order to protect the merchant from fraud caused by a customer with insufficient funds to cover the check.

Pare Jr. et al. ('148)does not explicitly disclose printing a check with a secure printer connected to the check printing station at the location remote from the client computer. Carlson et al. ('607) discloses printing a check.(Figure 6) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Carlson et al. ('607) method in order to allow the seller to generate physical proof of the transaction.

As per claim 7,

Pare Jr. et al. ('148) discloses the method of Claim 6

Pare Jr. et al. ('148) does not explicitly disclose the secure printer is a magnetic ink character recognition-enabled printer. Carlson et al. ('607) discloses the secure printer is a magnetic ink character recognition-enabled printer. (column 10, lines 54-57) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Carlson et al. ('607) method in order to generate a paper check that is routable via standard bank routing procedures.

As per claim 9,

Pare Jr. et al. ('148) discloses the method of Claim 6

where the network is the Internet.(Figure 4)

As per claim 10,

Pare Jr. et al. ('148) discloses the method of Claim 6

where the approval comprises the customer data transmitted from the client computer to the check server. (column 15, line 1-7)

As per claim 16

Pare Jr. et al. ('148) discloses a system for settling and verifying checks over a network comprising

a client computer connected via a network to a merchant server; (column 14, lines 34-42)

the merchant server is connected to a check printing station, a printer and a check server via a network; where by the client computer transmits an order to a merchant server at a location remote from the client computer (figure 6)

the client computer selects payment by check; (figure 6)

the client computer is connected to a check server; (column 13, lines 66-67; column 14, lines 1-19)

customer data is input to the client computer and transmitted to the check server (column 13, line 64)

the customer data is transmitted from the check server to a check verification server; (column 15, line 1-7)

an approval is transmitted from the check verification server to the client computer and the check server; (column 15, line 1-7)

Pare Jr. et al. ('148) does not explicitly disclose the approval is stored in a merchant file in the check server; the merchantfile is downloaded from the check server to the check printing station. Hills et al. ('528) discloses the approval is stored in a merchant file in the check server; (Abstract) the merchantfile is downloaded from the check server to the check printing station; (Column 12, lines 54-67) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Hills et al. ('528) method in order to protect the merchant from fraud caused by a customer with insufficient funds to cover the check.

Pare Jr. et al. ('148)does not explicitly disclose a check is printed by the printer Carlson et al. ('607) discloses a check is printed by the printer.(Figure 6) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Carlson et al. ('607) method in order to allow the seller to generate physical proof of the transaction.

As per claim 17

Pare Jr. et al. ('148) discloses the method of Claim 16

Pare Jr. et al. ('148) does not explicitly disclose the network is the ACH network. Hills et al. ('528) discloses the network is the ACH network. (Abstract) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Hills et al. ('528) method in order to utilize a well known and commercially viable system for check clearing.

As per claim 19,

Pare Jr. et al. ('148) discloses the method of Claim 16

Pare Jr. et al. ('148) does not explicitly disclose the printer is a magnetic ink character recognition-enabled printer. Carlson et al. ('607) discloses the printer is a magnetic ink character recognition-enabled printer. (column 10, lines 54-57) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Carlson et al. ('607) method in order to generate a paper check that is routable via standard bank routing procedures

Allowable Subject Matter

Claim 2,8,11 and 13 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
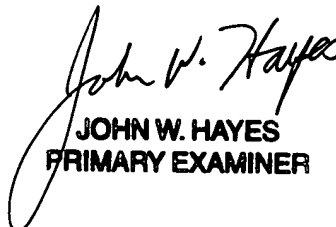
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW
July, 11 2003

JOHN W. HAYES
PRIMARY EXAMINER